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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/993,926

11/13/2001

Dominic Dough-Ming Cheung

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10/04/2007

BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE

P.O. BOX 10395

CHICAGO, IL 60610

EXAMINER

TINKLER, MURIEL S

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|--|--------------------------------------|--------------------------------------|--|
| <p align="center">Office Action Summary</p> | Application No. 09/993,926 | Applicant(s) CHEUNG ET AL. | |
| | Examiner Muriel Tinkler | Art Unit 3691 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ 5) <input type="checkbox"/> Notice of Informal Patent Application 6) <input type="checkbox"/> Other: _____ |
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DETAILED ACTION

This application has been reviewed. Claims 1-36 are pending. Claims 24-36 have been withdrawn and claims 3 and 4 have been cancelled. Therefore, Claims 1, 2 and 5-23 have been reviewed. The response to arguments and rejection(s) are stated below.

Response to Amendment

1. Amendments to claims 1 and 19 are not accepted. Claims 1 and 19 now contain matter that was not found in the specification, see below.

Response to Arguments

2. Applicant's arguments filed July 16, 2007, regarding the validity of the 35 USC 102(e) rejection have been fully considered but they are not persuasive. The Applicant argues that Davis is not a 'new grounds of rejection'. The Examiner states the 'new grounds of rejection' because the type of 35 USC 102 rejection changed from 35 USC 102(b) to 35 USC 102(e).
3. Applicant's arguments filed July 16, 2007, regarding the use of a 'bid cap' have been fully considered but they are not persuasive. The Examiner maintains that the claim language for 'bid cap' is similar, if not the same as, to the 'bid amount'.

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4. Applicant's arguments with respect to claims 1, 2 and 5-23 have been considered but are moot in view of the new ground(s) of rejection. Claims 1 and 19 are the independent claims of which claims 2, 5-18 and 20-23 depend. Claims 1 and 19 have been rejected based on 35 USC 112, 1st paragraph, see below. Therefore, all claims that depend from claims 1 and 19 are also rejected.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 2 and 5-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Claim 1 contains the amended text, "automatically adjusting the respective bid amounts for selected search listings according to the bid cap". The Applicant discusses the act of adjusting respective bid amounts for selected search listings according to the bid cap in several places throughout the specification, for example, on page 12 (lines 29-31). But, there is no mention of automatically adjusting bid amounts in any of these

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entries in the specification. Therefore, a 35 USC 112, 1st paragraph rejection is maintained for claim 1.

8. Claims 2, 5-18, 22 and 23 are rejected as being in the dependent form of claim 1.

9. Claim 19 contains the amended text, "search listings are automatically re-ordered in accordance with the received desired rank and bid cap". The Applicant discusses the act of presenting the results in rank order on page 12 (lines 20-22). There is no mention, anywhere in the specification, of automatically re-ordering the search listings in accordance with desired rank and bid cap. Therefore, a 35 USC 112, 1st paragraph rejection is maintained for claim 19.

10. Claims 20 and 21 are rejected as being in the dependent form of claim 19.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT
September 26, 2007



HANI M. KAZIMI
PRIMARY EXAMINER